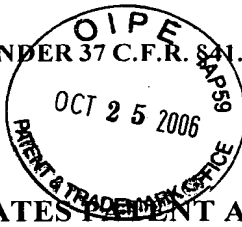


APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37
U.S. Application Serial No. 09/713,135
Attorney Docket No. 031796-0311562



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: JAVANGULA ET AL.
SERIAL NUMBER: 09/713,135 EXAMINER: Frantzy Poinvil
FILING DATE: November 14, 2000 ART UNIT: 3628
FOR: APPROACH FOR PROCESSING ELECTRONIC ORDERS

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on June 26, 2006, Appellants respectfully submit Appellants' Brief on Appeal pursuant to 37 C.F.R. § 41.37.

The Director is authorized to charge the \$250.00 fee for filing an Appeal Brief pursuant to 37 C.F.R. § 41.20(b)(2). The Director is further authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (Ref. No. 031792-0311562).

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REQUIREMENTS OF 37 C.F.R. §41.37

I. 37 C.F.R. § 41.37(c)(1)(i) – REAL PARTY IN INTEREST

The real party in interest is E-centives, Inc. by virtue of the assignment recorded at Reel 011680, Frames 0858-0862.

II. 37 C.F.R. § 41.37(c)(1)(ii) – RELATED APPEALS AND INTERFERENCES

Based on information and belief, there are no related appeals or interferences.

III. 37 C.F.R. § 41.37(c)(1)(iii) – Status of Claims

Pending: Claims 1-48 are pending.

Cancelled: No claims are cancelled.

Rejected: Claims 1-48 stand rejected.

Allowed: No claims have been allowed.

On Appeal: The rejection of claims 1-48 under 35 U.S.C. § 103(a) is appealed.

IV. 37 C.F.R. § 41.37(c)(1)(iv) – Status of Amendments

Appellants introduced claim amendments in an After Final Amendment filed on June 26, 2006. The Examiner entered the claim amendments as noted in the Examiner's Advisory Action mailed August 18, 2006.

V. 37 C.F.R. § 41.37(c)(1)(v) – Summary of Claimed Subject Matter

A. Overview of Disclosed Invention

Prior to setting forth a showing of specific support for the claimed subject matter, Appellants first provide the following overview of the disclosed invention. One aspect of the invention relates to enabling devices with minimal processing capabilities (e.g., mobile devices) to place electronic orders by using less than all of the information necessary for a merchant to fulfill an order. With reference to FIG. 1, first order data from a mobile customer device (102) may be sent to an intermediary (e.g., transaction facilitator (104)). Data item(s) needed to fulfill an order may be retrieved based on various factors. The retrieved data item(s) may be combined with the first order data to produce second order data. Second order data may be sent from the intermediary to a merchant (106) to complete the electronic ordering process.

In one implementation, customer device (102) may obtain product and service information in any form from a wireless application portal. See Specification, e.g., pg. 11, lines 13-23. Based on this information, customer device (102) can generate the first order data. The first order data may specify a merchant along with one or more products and/or services that a customer associated with the customer device desires to purchase. The first order data, however, may contain less than a minimum set of data required by the specified merchant to completely process the order. The first order data, along with device identification data, may be transmitted in an electronic order from a mobile customer device to an intermediary. The device identification data identifies customer device (102).

According to an aspect of the invention, the device identification data and corresponding information may be stored in a repository associated with the intermediary. See Specification, e.g., pg. 14, lines 11-23. The device identification data received from the mobile customer device may be used by the intermediary to retrieve corresponding information that can be used to complete the electronic order. For example, identification

data can be used to identify the billing and/or address information for a customer's device.

See Specification, e.g., pg 14, lines 11-24. The identification data may also be used to

identify instructions on how to communicate directly with the customer's device to

retrieve data for fulfilling the order. See Specification, e.g., pg. 16, line 13-pg. 17, line 2.

Device identification can identify the type of device, such that the device capabilities (e.g., communications protocol used, memory, graphics ability, etc.) can be identified.

Specification e.g., pg. 23, lines 9-11; and pg. 28, line 18-pg. 29, line 2.

In one implementation, the intermediary uses the received first order data (e.g., desired product/service and merchant) and device identification data to process the order.

A particular merchant may require a minimum set of data to be specified in the electronic order for it to be able to completely process the electronic order. For example, a merchant may require a product identification code, product description, product pricing, billing information, address information and/or any combination thereof to be specified within the electronic order. The intermediary stores information that specifies a minimum set of data needed by one or more merchants to process an order (e.g., product information, billing information, address information, etc). See Specification, e.g., pg. 15, lines 4-17.

The first order data may be compared with the stored information regarding the minimum set of data required by a particular merchant identified in the first order. Based on this comparison, and/or the device identification data, the intermediary may retrieve at least one data item that is needed to complete the minimum requirements specified for the merchant. For example, the comparison may reveal that the minimum amount of product information (e.g., product identification code) is not included in the first order data. Thus the product information may be retrieved at the intermediary. Further, as an additional example, the billing information may be missing from the first order data. The billing

information may be retrieved at the intermediary using the device identification data (e.g., telephone number).

The retrieved product information and billing information may comprise data items used to create second order data. Second order data may be generated by combining the one or more data items (e.g., product information, billing address) with the first order data. The second order data may include at least the minimum set of data required by the merchant to process the order. The second order data may be forwarded to the merchant (106) in order to complete the electronic order process.

This approach for processing orders enables customers (having customer devices (102) with limited capabilities) to place orders from their devices without having to provide a minimal set of data required by a merchant (106) to completely process the order. Among other things, this reduces the requirements (hardware and/or software) needed by a mobile device to effectuate e-commerce transactions. The invention further effectively reduces the amount of processing performed by a customer device to place orders, and also reduces the amount of bandwidth required by communication links. This is also beneficial for mobile customer devices running wireless applications where bandwidth is limited. Furthermore, customer device (102) is not required to provide order data in a format required by merchant (106).

B. Showing of Specific Support for Each of the Independent Claims

While the foregoing claim features are applicable to various ones of each of the independent claims, in order to fulfill the requirement under 37 C.F.R. § 41.37(c)(1)(v), the following succinctly shows support for claim features of each independent claim.

1. Claim 1

Claim 1 recites a method for processing electronic orders. The claim recites “receiving, at an intermediary disposed between and separate from a mobile device and a plurality of merchants, first order data for an order and device identification data from the mobile device, wherein the first order data includes data regarding one or more products or services that a user associated with the mobile device desires to purchase and data regarding one of the plurality of merchants from which the user desires to purchase the one or more products or services, yet includes less than a minimum set of data required by the one merchant to completely process the order, and wherein the device identification data identifies the mobile device” (see Specification, e.g., Fig. 1; pg. 10, lines 1-5; pg. 17, lines 3-5; and pg. 11, lines 3-12).

Claim 1 further recites, “storing, at an intermediary, information that specifies the minimum set of data required by at least the one merchant to completely process the order” (see Specification, e.g., pg. 4 lines 7-10; pg. 13, lines 1-6; pg. 15, lines 7-9; pg. 15, lines 7-9; pg. 16, lines 10-12), and “comparing, by the intermediary, first order data to the minimum set of data required by the one merchant to completely process the order” (see Specification, e.g., pg. 15, lines 4-7).

Claim 1 further recites, “retrieving, by the intermediary, based upon the comparison and the device identification data, at least one data item that is not included in the first order data, but that is needed to have the minimum set of data required by the one merchant to completely process the order” (see Specification, e.g., pg. 15, lines 9-17; and pg. 17, lines 3-5).

Claim 1 further recites, “generating, by the intermediary, based upon the first order data and the at least one data item, second order data that includes the minimum set of data

required by the one merchant to completely process the order” (see Specification, e.g., Fig. 2, 204-210; and pg. 12, lines 8-13).

Claim 1 further recites, “providing the second order data to the one merchant for processing” (see Specification, e.g., Fig. 2, 212).

2. Claim 15

In addition to the recitation described above with regard to independent claim 1, independent claim 15 further recites a computer readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors cause the one or more processors to perform the steps discussed above with respect to claim 1 (see Specification e.g., Fig. 6; and pg. 26, line 11- pg. 27, line 4).

3. Claim 29

In addition to the recitation described above with regard to independent claim 1, independent claim 29 recites: “[a] computer system for processing electronic orders comprising one or more processors; and a memory communicatively coupled to the one or more processors, wherein the memory includes one or more sequences of one more instructions which, when executed by the one or more processors, cause the one or more processors to perform the steps” (see Specification, e.g., Fig. 6; and pg. 26, line 11- pg. 27 line 4).

4. Claim 43

Claim 43 recites an apparatus for processing electronic orders. In particular, the claim recites: “an information repository” (see Specification, e.g., Fig. 1, 312; and pg. 14, lines 7-10). Claim 43 further recites “a transaction facilitator disposed between and separate from a mobile device and a plurality of merchants and communicatively coupled to the information repository” (see Specification, e.g., Fig. 1, 304; and pg. 13 lines 1-22).

Claim 43 further recites, “wherein the transaction facilitator is configured to receive from the mobile device over a wireless communications link first order data for an order and device identification data, wherein the first order data comprises information relating to one or more products or services that a user associated with the mobile device desires to purchase and information relating to one of the plurality of merchants from which the user desires to purchase the one or more products or services, yet includes less than a minimum set of data required by the one merchant to completely process the order and the device identification data identifies the mobile device” (see Specification, e.g., Fig. 1, pg. 10, lines 1-5; pg. 17, lines 3-5; and pg. 11, lines 3-12).

Claim 43 further recites, “store, at an intermediary, information that specifies a minimum set of data required by at least the one merchant to completely process an order” (see Specification, e.g., pg. 4, lines 7-10; pg. 13, lines 1-6; pg. 15, lines 7-9; pg. 15, lines 7-9; pg. 16, lines 10-12).

Claim 43 further recites, “compare, by the intermediary, first order data to the minimum set of data required by the one merchant to completely process the order” (see Specification, e.g., pg. 15, lines 4-7).

Claim 43 further recites, “retrieve from the information repository, based upon the comparison and the device identification data, at least one data item that is not contained in the first order data, but that is needed to have the minimum set of data required by the one merchant to completely process the order” (see Specification, e.g., pg. 15, lines 9-17; and pg. 17, lines 3-5).

Claim 43 further recites, “generate, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order” (see Specification, e.g., Fig. 2, 204-210; pg. 12,

lines 8-13) and “provide the second order data to the one merchant for processing” (see Specification, e.g., Fig. 2, 212).

C. Showing of Specific Support for Separately Argued Dependent Claims

1. Dependent Claims 2, 16, 30

Claim 2, 16, and 30 each recite “receiving user authentication data for a user associated with the mobile device” (see Specification, e.g., pg. 19, line 21- pg. 20 line 3), and “authenticating the user using the user authentication data” (see Specification, e.g., pg. 20, lines 3-15).

2. Dependent Claims 3, 17, 31

Claim 3 recites “wherein the user authentication data includes a Personal Identification Number (PIN) for the user” (see Specification, e.g., pg. 20, lines 5-6), and “wherein the method further comprises authenticating the user using the PIN.” (see Specification, e.g., pg. 20, lines 6-15).

Similarly, claim 17 recites, “wherein the computer-readable medium further comprises one or more additional sequences of instructions which, when executed by the one or more processors, cause the one or more processors to perform the step of authenticating the user using the PIN” (see Specification, e.g., pg. 20, lines 6-15).

Claim 31 recites, “wherein the memory includes one or more additional sequences of one or more instructions which, when executed by the one or more processors, cause the one or more processors to perform the step of authenticating the user using the PIN” (see Specification, e.g., pg. 20, lines 6-15).

3. Dependent Claims 7, 21, 35

Claims 7, 21, and 35 each recite, “wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data in a format required by the one merchant to completely process the order” (see Specification, e.g., pg. 21, line 10-13; and pg. 23, line 18- pg. 24, line 6).

4. Dependent Claims 9, 23, 37

Claims 9, 23, and 37 each recite, “determining that the one merchant cannot completely process the order” (see Specification, e.g., pg. 17, lines 3-5), and “providing the second order data to a second one of said plurality of merchants for processing” (see Specification, e.g., pg. 17, lines 5-14).

5. Dependent Claims 45-48

Claims 45-48 each recite “wherein the mobile device receives product and service information according to the type of mobile device and the communications protocol used by the mobile device as determined by the device identification data” (see Specification, e.g., pg. 23, line 18- pg. 24, line 6).

VI. 37 C.F.R. § 41.37(c)(1)(vi) – Grounds of Rejection to be Reviewed on Appeal (35 U.S.C. § 103).

Claims 1-48 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,664,110 to Green et al. (hereinafter referred to as “Green”) in view of U.S. Patent No. 5,826,245 to Sandberg-Diment.

VII. 37 C.F.R. § 41.37(c)(1)(vii) – Argument

A. Claims 1-48 are Patentable Under 35 U.S.C. § 103(a).

The Examiner legally erred in rejecting claims 1-48 under 35 U.S.C. § 103(a) over Green in view of Sandberg-Diment. Claims 1-48 are patentable for *at least* the reasons that: (1) the Examiner has failed to set forth a legally proper teaching, suggestion, or motivation to modify Green to include the teachings of Sandberg-Diment; and (2) assuming arguendo that there was a legally proper teaching, suggestion, or motivation to combine Green and Sandberg-Diment, the references, even if combined, fail to disclose, teach, or suggest all of the claim elements.

“The foundational facts for the prima facie case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art.” *In re Mayne*, 104 F.3d 1339, 1341, 41 U.S.P.Q. 2d (BNA) 1451, 1453 (Fed. Cir. 1997) (citing *Graham v. John Deere Co.*, 383 U.S. at 17-18, 86 S.Ct. at 693-94, 148 U.S.P.Q. (BNA) 459, 466-67; *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 877, 27 U.S.P.Q. 2d (BNA) 1123, 1128 (Fed. Cir. 1993)). When present, evidence of secondary considerations “must be considered in determining obviousness.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 667, 57 U.S.P.Q. 2d (BNA) 1161, 1169 (Fed. Cir. 2000).

Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. (BNA) 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. (BNA) 494, 496 (C.C.P.A. 1970).

Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d (BNA) 1596, 1598-99 (Fed. Cir. 1988).

1. The Examiner has failed to provide a legally proper teaching, suggestion, or motivation to modify Green to include the teachings of Sandberg-Diment.

The Examiner has failed to set forth a legally proper teaching, suggestion, or motivation to modify Green to include the teachings of Sandberg-Diment. For example, with regard to independent claims 1, 15, 29, and 43, the Examiner acknowledges that Green does not disclose the claimed feature of the order data including less than a minimum set of data required by the one merchant to completely process the order. See Final Office Action, pg. 5, lines 6-8. The Examiner relies on Sandberg-Diment, however, for at least this feature and *several* other features (Final Office Action, bottom of pg. 5), alleging that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Sandberg-Diment into the system of Green et al in order to allow a customer to complete a transaction in a secure manner.

Final Office Action, pg. 6.

Appellants disagree. The Examiner has failed to set forth a proper teaching, suggestion, or motivation to modify Green to include *all* of the different teachings of Sandberg-Diment relied upon by the Examiner. The Examiner has pointed to no teaching, suggestion, or motivation in either of the references, or in the knowledge generally available to one of ordinary skill in the art as to why it would have been obvious to modify Green to include all of the teachings of Sandberg-Diment relied upon by the Examiner.

Accordingly, it appears as though the Examiner has engaged in the classic exercise of hindsight reconstruction to pick and choose among separate disclosures to allegedly arrive at Appellants' claimed invention. The Examiner provides no evidence to support this assertion.

For *at least* this reason, there is no legally proper teaching, suggestion, or motivation to modify Green to include the teachings of Sandberg-Diment. Accordingly, the rejection is improper and should be reversed.

2. Green and Sandberg-Diment, even if combined, fail to disclose, teach, or suggest all of the elements of claims 1-48.

Assuming *arguendo* that Green and Sandberg-Diment could be combined, the combined references still fail to disclose, teach, or suggest all of the elements of claims 1-48.

a. Independent claim 1, 15, 29, and 43

Independent claims 1, 15, 29 and 43 each generally recite, *inter alia*, the features of:

receiving, at an intermediary disposed between and separate from a mobile device and a plurality of merchants...device identification data from the mobile device...wherein the device identification data identifies the mobile device;

[hereinafter, the “**receiving**” feature]

storing, at an intermediary, information that specifies the minimum set of data required by at least the one merchant to completely process the order;

[hereinafter, the “**storing**” feature]

comparing, by the intermediary, first order data to the minimum set of data required by the one merchant to completely process the order;

[hereinafter, the “**comparing**” feature]

retrieving, by the intermediary, based upon the comparison and the device identification data, at least one data item that is not included in the first order data;

[hereinafter, the “**retrieving**” feature]

The rejection under 35 U.S.C. § 103(a) should be reversed for at least the reasons that the Green/Sandberg-Diment combination does not appear to disclose, teach, or suggest at least the foregoing features.

1. ***Green/Sandberg-Diment does not teach the “receiving” feature.***

Independent claims 1, 15, 29 and 43 recite that an intermediary receives device identification data from a mobile device and the device identification data identifies the mobile device. Green, which is relied upon by the Examiner for this feature, appears to disclose a remote ordering system that allows a client’s display/processor unit (DPU) to communicate with a data format/transfer computer (DFTC) in order to obtain information from a merchant database regarding one or more products of interest. The DFTC controls flow of information between the DPU and the merchant database during an interactive session. See Green at col. 5, lines 2-12.

Although Green discloses various methods of communication between the DPU and DFTC including cellular, satellite, and fiber optic (See Green, col. 4, lines 61-67), Green does not disclose receiving device identification from a mobile device. In the Final Office Action, Examiner recites:

The system of Green et al is a mobile device since it is a portable device and transmits data using cellular or satellite or fiber optic communications. Most portable devices include an identification data serving as one of many user identifications. For example, cell phones identification data include cell phone number and device identification. Green et al require that user identification be transmitted with the purchase order. Transmitting device identification would have been one of the required identification to be transmitted in a purchase order or interaction with the DTFC 12 so as to preserve the integrity and security of the combined system of Green et al and Sandberg-Diment.

Final Office Action, pg. 3, lines 3-11.

The Examiner alleges that Green discloses user identification, and that transmitting device identification would have been required for the combined systems of Green and Sandberg-Diment. The Examiner fails to provide any citation or any relevant, identifiable source of information, however, supporting the statements made with respect to the claim feature of receiving device identification data that identifies the mobile device. Rather, the Examiner appears to be making broad conclusionary statements of generalized advantages and convenient assumptions to make a rejection without providing any factual support beyond "subjective belief and unknown authority." See *In re Lee*, 277 F.3d 1338, 1342-44, 61 U.S.P.Q. 2d (BNA) 1430, 1433-34 (Fed. Cir. 2002).

The Examiner's arguments with respect to this claim feature amount to mere unsupported speculation, which even if true, still do not disclose the claim feature. The Examiner alleges that Green discloses user identification, however, the claims recite "device identification identifies the mobile device." Green does not disclose *device* identification. Rather, Green discloses that a user is first identified to the merchant database according to information provided by scanning an identification control card. The identification control card carries a user number (e.g., credit card number) that represents

the user. See col. 11, lines 51-59. Device identification for order processing is not even contemplated in Green.

The devices mentioned in Green are merely data entry or command entry devices. See Green, col. 4 lines 40-60. In Green, the user, and *not the device*, is identified during order processing. Green makes no reference to device identification used to identify a mobile device. Accordingly, it is clear that Green fails to disclose the claim feature. Sandberg-Diment fails to cure this deficiency of Green. As acknowledged by the Examiner, Sandberg-Diment does not disclose a device identification that identifies a mobile device. See Final Office Action, pg. 3, lines 15-16. For at least these reasons, the rejection is improper and should be reversed.

2. ***Green/Sandberg-Diment does not teach the "storing" feature.***

The Examiner acknowledges that Green fails to disclose, among other things, the claim feature of "storing, at an intermediary, information that specifies the minimum set of data required by at least the one merchant to completely process the order." The Examiner attempts to rely on Sandberg-Diment to cure this deficiency. The Examiner broadly cites to Sandberg-Diment, at column 2, to reject this and *several* other claim features without any explanation with respect to each claim element. See Final Office Action, pg. 6, line 3. Neither column 2, nor any part of the disclosure presented in Sandberg-Diment, teaches or suggests this claim feature.

Sandberg-Diment is not concerned with placing orders from a customer device with limited capabilities. Rather, Sandberg-Diment discloses a method for providing secure transmission of a credit card number over an open network using a verification

agent (see figure 2). The verification agent stores a tagged piece of a credit card number which can be later matched with a corresponding tagged piece of a credit card number from a merchant.

The claim feature at issue, however, relates to information that indicates a minimum set of data required by a particular merchant to completely process an electronic order from beginning to end. See Specification, e.g., pg. 15, line 1- pg. 17, line 2. A credit card number, as taught by Sandberg-Diment, fails to suggest this feature because a credit card number by itself is merely the method of payment and specifies nothing about a minimum set of data required by a merchant to *completely* process an order. Information regarding a credit card number by itself is not enough information to completely process an order. At best, a credit card number is only a portion of information that is needed to place an entire order. The Examiner's rejection fails to present any evidence that suggests the claim feature. For at least the forgoing reasons, the rejection is improper and should be reversed.

3. ***Green/Sandberg-Diment does not teach the "comparing" feature.***

The Examiner fails to establish that the combination of Green and Sandberg-Diment discloses the "storing" feature, as recited in independent claims 1, 15, 29 and 43. Because Sandberg-Diment fails to disclose, teach, or suggest storing information that specifies a minimum set of data required by a merchant to completely process an order (as disclosed above), it necessarily follows that Sandberg-Diment also fails to disclose comparing first order data to a minimum set of data required by a merchant to completely process an order. Again, Sandberg-Diment appears to relate to comparing a tagged piece of a credit card number to stored, tagged pieces of credit card numbers in order to create a

whole credit card number. See Sandberg-Diment at col. 3, lines 43-63. A tagged piece of a credit card number is not a minimum set of data required by a merchant to *completely* process an order. Rather, it is only a portion of data required to place an order.

In Sandberg-Diment, the comparison is between two tagged credit card numbers and *not* a comparison between first order data and a minimum set of data required by a merchant to completely process an order, as claimed. The comparison results in nothing more than a credit card number which is only a portion of data required to place an order. The combination fails to suggest or teach the claimed feature. Therefore, the rejection is improper and should be reversed.

4. ***Green/Sandberg-Diment does not teach the “retrieving” feature.***

The Examiner alleges that Sandberg-Diment discloses the claim feature of “retrieving, by the intermediary, based upon the comparison and the device identification data, at least one data item that is not included in the first order data.” The Examiner’s rejection, however, fails to provide any evidentiary support for this allegation. Particularly, Sandberg-Diment fails to disclose retrieving, based upon the device identification data, at least one data item.

Sandberg-Diment compares tagged portions of credit card numbers in order to generate a full credit card number. Device identification is not considered in retrieving the credit card number. The Examiner concedes that Sandberg-Diment was not applied to denote teaching of device identification for a mobile device. See Final Office Action pg. 2 line 15-16. However, as stated above, Green also fails to disclose device identification. Green discloses that a user is first identified to a merchant database according to

information provided by scanning an identification control card. The identification control card carries a user number (e.g., credit card number) that represents the user. See col. 10, line 30-41; and col. 11, lines 51-59. Device identification is not considered in Green. Neither of the references viewed either alone, or in combination, teach or suggest the claim feature of retrieving at least one data item based on device identification data as claimed in claims 1, 15, 29, and 43. Therefore, the rejection is improper and should be reversed.

For each of the foregoing reasons, the rejection of independent claims 1, 15, 29 and 43 under 35 U.S.C. § 103(a) is factually unsupported and legally improper and should be reversed. Dependent claims 4-6, 8, 10-14, 18-20, 22, 24-28, 32-34, 36, 38-42 and 44 are allowable because they depend from allowable independent claims, as well as for the additional features they recite.

b. Dependent claims 2, 3, 7, 9, 16, 17, 21, 23, 30, 31, 35, 37, and 45-48.

Dependent claims 2, 3, 7, 9, 16, 17, 21, 23, 30, 31, 35, 37, and 45-48 are allowable because they depend from allowable independent claims, as well as for the further features they recite, as described below.

1. ***Claims 2, 3, 16, 17, 30 and 31.***

Claims 2, 16, and 30 each recite “receiving user authentication data for a user associated with a mobile device, and authenticating the user using the user authentication data.” The Examiner erroneously alleges that Green discloses this feature. Green relates

to associating a user with a merchant and account number. The Examiner does not establish that Green discloses a user associated with a mobile device.

Claims 3, 17, and 31 depend from claim claims 2, 16, and 30, respectively, and further recite that the user authentication data includes a PIN for the user. For at least these reasons, the rejection of claims 2, 3, 16, 17, 30, and 31 under 35 U.S.C. §103(a) over the combination of Green and Sandberg-Diment is improper, and should be reversed.

2. *Claims 7, 21, and 35.*

These claims recite, among other things, “second order data that includes the minimum set of data in a format required by the one merchant to completely process the order.” The Examiner does not establish that either reference discloses this. Neither Green nor Sandberg-Diment, when viewed either alone or in combination, discloses a format required by a merchant to completely process an order. For at least these reasons, the rejection of claims 7, 21, and 35 under 35 U.S.C. §103(a) over the combination of Green and Sandberg-Diment is improper, and should be reversed.

3. *Claims 9, 23, and 37.*

Claims 9, 23, 37, each recite “determining that the one merchant cannot completely process the order; and providing the second order data to a second one of said plurality of merchants for processing.” The rejection fails to establish that the references relied upon by the Examiner disclose this feature. For at least these reasons, the rejection of claims 9, 23, and 37 under 35 U.S.C. §103(a) over the combination of Green and Sandberg-Diment is improper, and should be reversed.

4. *Claims 45-48.*

Claims 45-48 each recite “wherein the mobile device receives product and services information according to the type of mobile device and the communications protocol used

by the mobile device as determined by the device identification data. Green relates to communications depending on the location of the merchant database and/or user profile information, *not* the mobile device identification data. See col. 5 lines 7-21; and 30-43. The Examiner does not establish that the relied upon references disclose the features of claims 45-48 as claimed. For at least these reasons, the rejection of claims 45-48 under 35 U.S.C. §103(a) over the combination of Green and Sandberg-Diment is improper, and should be reversed.

VIII. 37 C.F.R. §41.37(c)(1)(viii) - CLAIMS APPENDIX

Appendix A: The pending claims (claims 1-38) are attached in Appendix A.

IX. 37 C.F.R. §41.37(c)(1)(ix) - EVIDENCE APPENDIX

Appendix B: (None)

X. 37 C.F.R. §41.37(c)(1)(x) - RELATED PROCEEDINGS INDEX

Appendix C: (None)

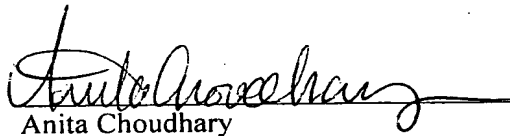
CONCLUSION

For at least the foregoing reasons, Appellant respectfully requests that the rejection of each of the pending claims 1-48 under 35 U.S.C. §103(a) be reversed.

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Respectfully submitted,

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APPENDIX A

CLAIMS

1. **(Previously Presented)** A method for processing electronic orders comprising the computer implemented steps of:

receiving, at an intermediary disposed between and separate from a mobile device and a plurality of merchants, first order data for an order and device identification data from the mobile device, wherein the first order data includes data regarding one or more products or services that a user associated with the mobile device desires to purchase and data regarding one of the plurality of merchants from which the user desires to purchase the one or more products or services, yet includes less than a minimum set of data required by the one merchant to completely process the order, and wherein the device identification data identifies the mobile device;

storing, at an intermediary, information that specifies the minimum set of data required by at least the one merchant to completely process the order;

comparing, by the intermediary, first order data to the minimum set of data required by the one merchant to completely process the order;

retrieving, by the intermediary, based upon the comparison and the device identification data, at least one data item that is not included in the first order data, but that is needed to have the minimum set of data required by the one merchant to completely process the order;

generating, by the intermediary, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order; and

providing the second order data to the one merchant for processing.

2. **(Previously Presented)** The method as recited in Claim 1, wherein the method further comprises:

receiving user authentication data for a user associated with the mobile device,
and

authenticating the user using the user authentication data.

3. **(Previously Presented)** The method as recited in Claim 2, wherein the user authentication data includes a Personal Identification Number (PIN) for the user and wherein the method further comprises authenticating the user using the PIN.
4. **(Previously Presented)** The method as recited in Claim 1, wherein the first order data further comprises user identification data that identifies the user,
wherein the method further comprises retrieving, based upon the customer user identification data, order fulfillment information associated with the user and
wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one data item and the order fulfillment information, second order data that includes the minimum set of data required by the one merchant to completely process the order.
5. **(Previously Presented)** The method as recited in Claim 4, wherein the order fulfillment information includes billing information for the user,
wherein the step of retrieving order fulfillment information associated with the user includes retrieving billing information for the user and
wherein the step of generating, based upon the first order data, the at least one data item and the order fulfillment information, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one data item and the billing information, second order data that includes the minimum set of data required by the one merchant to completely process the order.
6. **(Previously Presented)** The method as recited in Claim 4, wherein the order fulfillment information includes shipping information for the user and

wherein the step of retrieving order fulfillment information associated with the user includes retrieving shipping information for the user.

7. **(Previously Presented)** The method as recited in Claim 1, wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data in a format required by the one merchant to completely process the order.

8. **(Previously Presented)** The method as recited in Claim 1, wherein the method further comprises retrieving product information based upon the first order data, and
wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one data item and the product information, second order data that includes the minimum set of data required by the one merchant to completely process the order.

9. **(Previously Presented)** The method as recited in Claim 1, wherein the method further comprises:
determining that the one merchant cannot completely process the order; and
providing the second order data to a second one of said plurality of merchants for processing.

10. **(Previously Presented)** The method as recited in Claim 1, wherein the order is for a particular product or service,
wherein the order cannot be completely processed by the one merchant, and
wherein the step of generating, based upon the first order data and the at least one data item, the second order data includes generating, based upon the first order data and

the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process an order for a second product or service.

11. **(Previously Presented)** The method as recited in Claim 1, wherein the first order data and the device identification data are received from the mobile device over a wireless communications link.

12. **(Previously Presented)** The method as recited in Claim 1, wherein the mobile device is a mobile telephone and wherein the device identification data is a telephone number for the mobile telephone.

13. **(Previously Presented)** The method as recited in Claim 1, wherein the mobile device is a personal digital assistant.

14. **(Previously Presented)** The method as recited in Claim 1, wherein the mobile device is a mobile personal computer.

15. **(Previously Presented)** A computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

receiving, at an intermediary disposed between and separate from a mobile device and a plurality of merchants, first order data for an order and device identification data from the mobile device, wherein the first order data includes data regarding one or more products or services that a user associated with the mobile device desires to purchase and data regarding one of the plurality of a merchants from which the user desires to purchase the one or more products or services, yet includes less than a minimum set of data required by the one merchant to completely process the order, and wherein the device identification data identifies the mobile device;

storing, at an intermediary, information that specifies the minimum set of data required by at least the one merchant to completely process an order;

comparing, by the intermediary, first order data to the minimum set of data required by the one merchant to completely process the order;

retrieving, by the intermediary, based upon the comparison and the device identification data, at least one data item that is not included in the first order data, but that is needed to have the minimum set of data required by the one merchant to completely process the order;

generating, by the intermediary, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order; and

providing the second order data to the one merchant for processing.

16. **(Previously Presented)** The computer-readable medium as recited in Claim 15, further comprising one or more additional sequences of instructions which, when executed by the one or more processors, cause the one or more processors to perform the steps of:

receiving user authentication data for a user associated with the mobile device;

and

authenticating the user using the user authentication data.

17. **(Previously Presented)** The computer-readable medium as recited in Claim 16, wherein the user authentication data includes a Personal Identification Number (PIN) for the user, and

wherein the computer-readable medium further comprises one or more additional sequences of instructions which, when executed by the one or more processors, cause the one or more processors to perform the step of authenticating the user using the PIN.

18. **(Previously Presented)** The computer-readable medium as recited in Claim 15, wherein the first order data further comprises user identification data that identifies a user,

wherein the computer-readable medium further comprises one or more additional sequences of instructions which, when executed by the one or more processors, cause the one or more processors to perform the step of retrieving, based upon the user identification data, order fulfillment information associated with the user, and

wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one data item and the order fulfillment information, second order data that includes the minimum set of data required by the one merchant to completely process the order.

19. **(Previously Presented)** The computer-readable medium as recited in Claim 18, wherein the order fulfillment information includes billing information for the user,

wherein the step of retrieving order fulfillment information associated with the user includes retrieving billing information for the user, and

wherein the step of generating, based upon the first order data, the at least one data item and the order fulfillment information, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one data item and the billing information, second order data that includes the minimum set of data required by the one merchant to completely process the order.

20. **(Previously Presented)** The computer-readable medium as recited in Claim 18, wherein the order fulfillment information includes shipping information for the user, and

wherein the step of retrieving order fulfillment information associated with the user includes retrieving shipping information for the user.

21. **(Previously Presented)** The computer-readable medium as recited in Claim 15, wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one

merchant to completely process the order includes generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data in a format required by the one merchant to completely process the order.

22. **(Previously Presented)** The computer-readable medium as recited in Claim 15, further comprising one or more additional sequences of instructions which, when executed by the one or more processors, cause the one or more processors to perform the steps of:

retrieving product information based upon the first order data, and the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one, data item and the product information, second order data that includes the minimum set of data required by the one merchant to completely process the order.

23. **(Previously Presented)** The computer-readable medium as recited in Claim 15, further comprising one or more additional sequences of instructions which, when executed by the one or more processors, cause the one or more processors to perform the steps of:

determining that the one merchant cannot completely process the order; and providing the second order data to a second one of said plurality of merchants for processing.

24. **(Previously Presented)** The computer-readable medium as recited in Claim 15, wherein the order is for a particular product or service,

wherein the order cannot be completely processed by the one merchant, and

wherein the step of generating, based upon the first order data and the at least one data item, the second order data includes generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data

required by the one merchant to completely process an order for a second product or service.

25. **(Previously Presented)** The computer-readable medium as recited in Claim 15, wherein the first order data and the device identification data are received from the mobile device over a wireless communications link.

26. **(Previously Presented)** The computer-readable medium as recited in Claim 15, wherein the mobile device is a mobile telephone and
wherein the device identification data is a telephone number for the mobile telephone.

27. **(Previously Presented)** The computer-readable medium as recited in Claim 15, wherein the mobile device is a personal digital assistant.

28. **(Previously Presented)** The computer-readable medium as recited in Claim 15, wherein the mobile device is a mobile personal computer.

29. **(Previously Presented)** A computer system for processing electronic orders comprising:

one or more processors; and

a memory communicatively coupled to the one or more processors, wherein the memory includes one or more sequences of one more instructions which, when executed by the one or more processors, cause the one or more processors to perform the steps of:

receiving, at an intermediary disposed between and separate from a mobile device and a plurality of merchants, first order data for an order and device identification data from the mobile device, wherein the first order data includes data regarding one or more products or services that a user associated with the mobile device desires to purchase and data regarding one of the plurality of merchants from which the user desires to purchase the one or more products or services, yet includes less than a minimum set of data

required by the one merchant to completely process the order, and wherein the device identification data identifies the mobile device;

storing, at an intermediary, information that specifies the minimum set of data required by at least the one of merchant to completely process an order;

comparing, by the intermediary, first order data to the minimum set of data required by the one merchant to completely process the order;

retrieving, by the intermediary, based upon the comparison and the device identification data, at least one data item that is not included in the first order data, but that is needed to have the minimum set of data required by the one merchant to completely process the order;

generating, by the intermediary, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order; and

providing the second order data to the one merchant for processing.

30. **(Previously Presented)** The computer system as recited in Claim 29, wherein the memory includes one or more additional sequences of one or more instructions which, when executed by the one or more processors, cause the one or more processors to perform the steps of:

receiving user authentication data for a user associated with the mobile user device, and

authenticating the user using the user authentication data.

31. **(Previously Presented)** The computer system as recited in Claim 30, wherein the user authentication data includes a Personal Identification Number (PIN) for the user and

wherein the memory includes one or more additional sequences of one or more instructions which, when executed by the one or more processors, cause the one or more processors to perform the step of authenticating the user using the PIN.

32. **(Previously Presented)** The computer system as recited in Claim 29, wherein the first order data further comprises user identification data that identifies a user,

wherein the memory includes one or more additional sequences of one or more instructions which, when executed by the one or more processors, cause the one or more processors to perform the step of retrieving, based upon the user identification data, order fulfillment information associated with the user and

wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one data item and the order fulfillment information, second order data that includes the minimum set of data required by the one merchant to completely process the order.

33. **(Previously Presented)** The computer system as recited in Claim 32, wherein: the order fulfillment information includes billing information for the user,

wherein the step of retrieving order fulfillment information associated with the user includes retrieving billing information for the user and

wherein the step of generating, based upon the first order data, the at least one data item and the order fulfillment information, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one data item and the billing information, second order data that includes the minimum set of data required by the one merchant to completely process the order.

34. **(Previously Presented)** The computer system as recited in Claim 32, wherein the order fulfillment information includes shipping information for the user and

wherein the step of retrieving order fulfillment information associated with the user includes retrieving shipping information for the user.

35. **(Previously Presented)** The computer system as recited in Claim 29, wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data in a format required by the one merchant to completely process the order.

36. **(Previously Presented)** The computer system as recited in Claim 29, wherein the memory includes one or more additional sequences of one or more instructions which, when executed by the one or more processors, cause the one or more processors to perform the step of retrieving product information based upon the first order data, and
wherein the step of generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order includes generating, based upon the first order data, the at least one data item and the product information, second order data that includes the minimum set of data required by the one merchant to completely process the order.

37. **(Previously Presented)** The computer system as recited in Claim 29, wherein the memory further includes one or more additional sequences of one or more instructions which, when executed by the one or more processors, cause the one or more processors to perform the steps of:
determining that the one merchant cannot completely process the order, and
providing the second order data to a second one of said plurality of merchants for processing.

38. **(Previously Presented)** The computer system as recited in Claim 29, wherein the order is for a particular product or service,
wherein the order cannot be completely processed by the merchant, and

wherein the step of generating, based upon the first order data and the at least one data item, the second order data includes generating, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process an order for a second product or service.

39. **(Previously Presented)** The computer system as recited in Claim 29, wherein the first order data and the device identification data are received from the mobile device over a wireless communications link.

40. **(Previously Presented)** The computer system as recited in Claim 29, wherein the mobile device is a mobile telephone and the device identification data is a telephone number for the mobile telephone.

41. **(Previously Presented)** The computer system as recited in Claim 29, wherein the mobile device is a personal digital assistant.

42. **(Previously Presented)** The computer system as recited in Claim 29, wherein the mobile device is a mobile personal computer.

43. **(Previously Presented)** An apparatus for processing electronic orders comprising:

an information repository; and

a transaction facilitator disposed between and separate from a mobile device and a plurality of merchants and communicatively coupled to the information repository, wherein the transaction facilitator is configured to:

receive from the mobile device over a wireless communications link first order data for an order and device identification data, wherein the first order data comprises information relating to one or more products or services that a user associated with the mobile device desires to purchase and information relating to one of the plurality of

merchants from which the user desires to purchase the one or more products or services, yet includes less than a minimum set of data required by the one merchant to completely process the order and the device identification data identifies the mobile device;

store, at an intermediary, information that specifies a minimum set of data required by at least the one merchant to completely process an order;

compare, by the intermediary, first order data to the minimum set of data required by the one merchant to completely process the order;

retrieve from the information repository, based upon the comparison and the device identification data, at least one data item that is not contained in the first order data, but that is needed to have the minimum set of data required by the one merchant to completely process the order;

generate, based upon the first order data and the at least one data item, second order data that includes the minimum set of data required by the one merchant to completely process the order, and

provide the second order data to the one merchant for processing.

44. **(Previously Presented)** The apparatus as recited in Claim 43, wherein the one merchant is configured with a web-based order interface, and

wherein the second order data is provided directly to the one merchant, circumventing the web-based order interface.

45. **(Previously Presented)** The method of claim 1, wherein the mobile device receives product and service information according to the type of mobile device and the communications protocol used by the mobile device as determined by the device identification data.

46. **(Previously Presented)** The computer-readable medium as recited in Claim 15, wherein the mobile device receives product and service information according to the type of mobile device and the communications protocol used by the mobile device as determined by the device identification data.

47. **(Previously Presented)** The computer system as recited in Claim 29, wherein the mobile device receives product and service information according to the type of mobile device and the communications protocol used by the mobile device as determined by the device identification data.

48. **(Previously Presented)** The apparatus as recited in Claim 43, wherein the mobile device receives product and service information according to the type of mobile device and the communications protocol used by the mobile device as determined by the device identification data.

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 09/713,135
Attorney Docket No.031796-0311562

APPENDIX B

EVIDENCE APPENDIX

NONE

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

U.S. Application Serial No. 09/713,135

Attorney Docket No.031796-0311562

APPENDIX C

RELATED PROCEEDINGS INDEX

NONE